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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,650	12/20/2001	Anton C. Rothwell	NA11P056/01.187.01	2721
28875	7590	11/02/2006	EXAMINER	
Zilka-Kotab, PC P.O. BOX 721120 SAN JOSE, CA 95172-1120			CHEA, PHILIP J	
			ART UNIT	PAPER NUMBER
			2153	

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/028,650

Applicant(s)

ROTHWELL ET AL.

Examiner

Philip J. Chea

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31,33 and 34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31,33 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 2/16/06.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

This Office Action is in response to an Appeal Brief filed August 7, 2006. Claims 1-31, and 33-34 are currently pending. The Finality of the previous rejection has been withdrawn. However, the Examiner is reopening prosecution with a new grounds of rejection presented below.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4,6-31 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Makinson et al. (US 7,023,861), herein referred to as Makinson.

As per claim 1, Makinson discloses a network adapter system, comprising:

a processor positioned on a network adapter (14, 16) coupled between a computer and a network (Figs. 3,4,5 and 8);

wherein the processor is adapted for virus scanning and content scanning of network traffic transmitted between the computer and the network (see column 5, line 67 – column 6, line 4);

wherein the virus scanning utilizes virus signature files to scan for known types of malicious programs or data (see column 5, line 67 – column 6, line 4, where virus signatures are considered virus definitions);

wherein the virus signature files are stored on non-volatile solid state memory on the network adapter (see column 5, lines 57-67, where program (i.e. virus scanning, signature files, etc.) can be stored on read only memory).

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As per claim 2, Makinson further disclose that the processor is capable of being user-configured (see column 6, lines 10-12).

As per claim 3, Makinson further disclose that the processor is capable of being user-configured locally (see column 6, lines 10-12)

As per claim 4, Makinson further disclose that the processor is capable of being user-configured remotely via a network connection with the network adapter (see column 6, lines 12-16).

As per claim 6, Makinson further disclose that the manner in which the scanning is performed is capable of being user-configured (see column 6, lines 18-26, where software scanning or hardware scanning may be selected).

As per claim 7, Makinson further disclose that the settings of the network adapter are capable of being user-configured (see column 6, lines 10-16).

As per claim 8, Makinson further disclose that the processor is capable of determining whether received packets are of interest (see Makinson column 4, lines 50-57).

As per claim 9, Makinson further disclose that the packets of interest are based on an associated protocol (see Makinson column 4, lines 50-57).

As per claim 10, Makinson further disclose that the processor is capable of passing received packets that are not of interest to the computer (see Makinson column 4, lines 57-59).

As per claim 11, Makinson further disclose that the processor is capable of scanning received packets that are of interest (see column 4, lines 50-57).

As per claim 12, Makinson further disclose that the processor is capable of denying received packets that fail the scan (see column 5, lines 22-36).

As per claim 13, Makinson further disclose that the scan is performed based on user settings (see column 6, lines 10-16).

As per claims 14,27,28, Makinson discloses a method for scanning network traffic on a network adapter, comprising:

receiving packets at a network adapter including a processor positioned thereon (see column 4, lines 50-65);

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virus scanning and content scanning of the packets utilizing the processor (see column 5, line 67 – column 6, line 4); and

conditionally taking security measures if the packets fail the scan (see column 5, lines 22-36); wherein the virus scanning utilizes virus signature files to scan for known types of malicious programs or data (see column 5, lines 22-36);

wherein the virus signature files are stored on non-volatile solid state memory on the network adapter (see column 5, lines 57-67, where program (i.e. virus scanning, signature files, etc.) can be stored on read only memory).

As per claims 15-26, see rejection for claims 2-13 above.

As per claim 29, Makinson discloses a network adapter system, comprising:

a processor positioned on a network adapter coupled between a computer and a network, the processor including a packet assembly module, random access memory (RAM), and a scanner module (see Fig. 8, [14,16], where packet assembly module is considered the bridge packet analysis [56]);

a user interface driver for identifying network traffic of interest transmitted between the computer and the network (see column 4, lines 50-65);

wherein the processor is adapted for discerning and virus scanning and content scanning of network traffic of interest transmitted between the computer and the network (see column 5, lines 22-36);

wherein the virus scanning utilizes virus signature files to scan for known types of malicious programs or data (see column 5, line 67 – column 6, line 4);

wherein the virus signature files are stored on non-volatile solid state memory on the network adapter (see column 5, lines 57-67, where program (i.e. virus scanning, signature files, etc.) can be stored on read only memory).

As per claim 30, Makinson further disclose that the content scanning enforces operational policies of an organization (see column 6, lines 28-30).

As per claim 31, Makinson further disclose that the policies include detecting entities selected from the group consisting of harassing content, pornographic content, junk e-mails, and misinformation (see column 5, lines 22-26).

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As per claim 34, Makinson further disclose that the packets that are of interest include executable files (see column 5, lines 22-26).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5,33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Makinson as applied to claim 1 and 2 above, and further in view of Bonomo et al. (US 6,658,562), herein referred to as Bonomo.

Although the system disclosed by Makinson shows substantial features of the claimed invention (discussed above), it fails to disclose that memory is user protected by configuring a network adapter BIOS with a password that only a user can change.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Makinson, as evidenced by Bonomo.

In an analogous art, Bonomo discloses a system for setting different BIOS configurations stored in a memory device (see Abstract). Further showing setting a password to view information in a BIOS setup program or to change configuration (see column 4, lines 11-21 and 30-41).

Given the teaching of Bonomo, a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Makinson by employing a password protected BIOS, such as disclosed by Bonomo, in order to prevent unwanted users from changing settings without authorization.

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Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip J. Chea whose telephone number is 571-272-3951. The examiner can normally be reached on M-F 7:00-4:30 (1st Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Philip J Chea
Examiner
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PJC 10/16/06


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